

### **REMARKS**

Claims 1, 2, 5, 7, and 9 are currently pending, wherein claims 3, 4, 6, and 8 have been canceled, and claim 9 has been amended. Favorable reconsideration is respectfully requested in view of the remarks presented herein below.

On page 2 of the Office action ("Action"), the Examiner rejects claims 1-8 under 35 U.S.C. 112, second paragraph, as being indefinite. More specifically, the Examiner asserts "it is not clear how the winning notification will be attached to the email that has not been saved, after the winner of the lottery is determined." Applicants respectfully traverse this rejection.

In rejecting claims 1-8, the Examiner asserts that it is unclear how the winning notification will be attached to an email that has been saved. From the Examiner's comments it appears that the Examiner has misinterpreted the claimed invention to require that the winning notification be attached to a previously stored mail, which is not the case. Accordingly, to the present invention upon determination of winning mobile terminal, a winning notification is attached to one of the any of the emails forwarded (i.e., sent through the server) to the winning mobile terminal. Accordingly, the email does not need to be stored prior to attaching the winning notification as one skilled in the art would readily recognize that information can be attached to an email as it is being processed through the server. Reconsideration and withdrawal of the rejection of claims 1-8 under 35 U.S.C. 112, second paragraph is respectfully requested.

Further on page 2 of the Action, the Examiner rejects claims 3 and 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2004/0117245 A1 to Gogerty ("Gogerty"). Claim 3 has been canceled rendering this rejection moot with regard thereto. Regarding claim 9, Applicants respectfully traverse this rejection.

Independent claim 9, as amended, recites a winning probability decider. As noted by the Examiner on page 12 of the Action, Gogerty fails to disclose a winning probability decider. Accordingly, claim 9 is patentable over Gogerty because Gogerty fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 9 under 35 U.S.C. § 102(e) is respectfully requested.

On page 9 of the Action, the Examiner rejects claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of U.S. Patent No. 5,697,844 to Von Kohorn ("Von Kohorn"). Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 103, the Examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness three criteria must be met. First, there must be some motivation to combine the cited references. Second, there must be a reasonable expectation of success. Finally, the combination must teach each and every claimed element. In the present case, claim 1 is patentable over the combination of Gogerty and Von Kohorn for at least the reason that the combination fails to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots applied to a user of the second mobile terminal according to the send information stored in the storage as claimed.

In rejecting claim 1, the Examiner notes that Gogerty fails to disclose a winning probability decider as claimed. Therefore, the Examiner relies on Von Kohorn to overcome the deficiencies of Gogerty. More specifically, the Examiner asserts that Von Kohorn discloses a winning probability decider as claimed in as much as Von Kohorn discloses "entered response with superior scores are weighted so as to increase the probability of winning." Although, as noted by the Examiner, Von Kohorn discloses weighting the response with correct answers, nowhere in Von Kohorn is there any disclosure or suggestion of weighting the response according to the "send information" (e.g., number of received emails and total amount of received data by said first and second mobile terminals) stored in the server as claimed.

In addition, the Examiner's combination of Gogerty and Von Kohorn is based on improper hindsight reconstruction in as much as the Examiner's motivation (i.e., "so that the customers that either receive more e-mails or have larger volume...have a better chance of winning...") is only disclosed in the instant application.

Since Gogerty and Von Kohorn both fails to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots according to the send information as claimed, the combination of these two references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Gogerty and Von

Kohorn, which Applicants do not concede, the combination would still fail to render claim 1 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 1 under 35 U.S.C. § 103 is respectfully requested.

On page 13 of the Action, the Examiner rejects claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Von Kohorn, further in view of U.S. Patent Application Publication No. 2001/0051896 A1 to Noh et al. ("Noh"). Applicants respectfully traverse this rejection.

Claim 2 depends from independent claim 1. Therefore, claim 2 is patentable over the combination of Gogerty and Von Kohorn for at least those reasons presented above with respect to claim 1. Noh discloses a system for electronic mail enclosing a gift coupon. However, Noh fails to overcome the deficiencies of Gogerty and Von Kohorn.

Since Gogerty, Von Kohorn, and Noh each fail to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots according to the send information as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Gogerty, Von Kohorn, and Noh, which Applicants do not concede, the combination would still fail to render claim 2 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 2 under 35 U.S.C. §103 is respectfully requested.

On page 15 of the Action, the Examiner rejects claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Noh. Claim 4 has been canceled, rendering this rejection moot.

On page 17 of the Action, the Examiner rejects claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Von Kohorn, further in view of U.S. Patent Application Publication No. 2002/0061778 A1 to Acres ("Acres"). Applicants respectfully traverse this rejection.

Claim 4 depends from independent claim 1. Therefore, claim 4 is patentable over the combination of Gogerty and Von Kohorn for at least those reasons presented above with respect

to claim 1. Acres discloses a method and system for playing computer games sent via electronic mail. However, Acres fails to overcome the deficiencies of Gogerty and Von Kohorn.

Since Gogerty, Von Kohorn, and Acres each fail to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots according to the send information as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Gogerty, Von Kohorn, and Acres, which Applicants do not concede, the combination would still fail to render claim 4 unpatentable because the combination fails to disclose each and every claimed element. Reconsideration and withdrawal of the rejection of claim 4 under 35 U.S.C. §103 is respectfully requested.

On page 19 of the Action, the Examiner rejects claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Acres. Claim 6 has been canceled, rendering this rejection moot.

On page 21 of the Action, the Examiner rejects claim 7 under 35 U.S.C. § 103(a) as being unpatentable over Gogerty in view of Von Kohorn, further in view of Acres, and still further in view of U.S. Patent Application Publication No. 2003/0191816 A1 to Landress et al. ("Landress").

Claim 7 depends from independent claim 1. Therefore, claim 7 is patentable over the combination of Gogerty and Von Kohorn for at least those reasons presented above with respect to claim 1. Landress discloses a system and method for creating and delivering customized multimedia communications. However, Landress fails to overcome the deficiencies of Gogerty and Von Kohorn.

Since Gogerty, Von Kohorn, and Landress each fail to disclose or suggest a winning probability decider for deciding a winning probability of a drawing of lots according to the send information as claimed, the combination of these three references cannot possibly disclose or suggest said element. Therefore, even if one skilled in the art were motivated to combine Gogerty, Von Kohorn, and Landress, which Applicants do not concede, the combination would still fail to render claim 7 unpatentable because the combination fails to disclose each and every

claimed element. Reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. §103 is respectfully requested.

On page 23 of the Action, the Examiner rejects claim 8 under 35 U.S.C. §103(a) as being unpatentable over Gogerty, in view of Acres, further in view of Landress. Claim 8 has been canceled, rendering this rejection moot.

The application is in condition for allowance. Notice of same is earnestly solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Penny Caudle Reg. No. 46,607 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Dated: April 20, 2009

Respectfully submitted,

By Penny Caudle #46,607  
Chad J. Billings  
Registration No.: 48,917  
BIRCH, STEWART, KOLASCH & BIRCH, LLP  
8110 Gatehouse Road  
Suite 100 East  
P.O. Box 747  
Falls Church, Virginia 22040-0747  
(703) 205-8000